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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/678,601

10/03/2003

Franz-Josef Stark

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EXAMINER

BAREFORD, KATHERINE A

ART UNIT

PAPER NUMBER

1792

NOTIFICATION DATE

DELIVERY MODE

09/29/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspatents@senniger.com

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/678,601	Applicant(s) STARK ET AL.	
	Examiner Katherine A. Bareford	Art Unit 1792	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 September 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 48,52,53,59,61 and 67-71.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Katherine A. Bareford/
Primary Examiner, Art Unit 1792

Continuation of 3. NOTE: the proposed amendment to claim 48 raises new issues that would require further consideration and/or search by the Examiner as (a) the claim would require the use of both "2-hydroxypropanoic acid and propanedioic acid" which was not previously required, (b) the claim would require the plated nickel-phosphorous layer to have between 2-7% phosphorous, which was not previously required, and which would also raise 35 USC 112 issues as no units such as volume or weight are provided to tell how the percentage is measured. New claims 72-78 would also require new features as to the makeup solutions not previously required..

Continuation of 11. does NOT place the application in condition for allowance because: (1) as to the proposed amendments to overcome the 35 USC 112 rejection of claims 70 and 71, as the proposed amendment has not been entered for the reasons discussed in Box 3 above, the rejection stands for the reasons given in the Final Rejection of April 14, 2009. (2) As to the 35 USC 103 rejection using Harbulak, Gulla and Parker, the Examiner has reviewed applicant's arguments, however, the rejection is maintained. As to the arguments regarding the use of 2-hydroxypropanoic acid and propanedioic acid and the arguments as to the amount of phosphorous in the plated nickel-phosphorous layer, these only apply to the claims as proposed to be amended, and as the proposed amendment has not been entered as discussed in Box 3 above, they have not been considered. As to applicant's arguments that Harbulak is not really teaching 14-22 MTO, the Examiner notes that Harbulak provides no explicit limitation of the number of MTO's, indicating more than 8 turnovers can be used (applicant's reference to Harbulak's statements of 6-10 are specifically stated by Harbulak to apply to the "prior art practice" (see column 9, line 49)). As noted in MPEP 2121, references are assumed to be operable without applicant providing facts showing otherwise. Moreover, the Examiner combined Harbulak with Gulla as providing a specific suggestion and method for providing a no-limit number of plating cycles. As to Gulla being theoretical, the Examiner notes again the teaching in MPEP 2121 as to the understanding that the reference is operable. As to Harbulak not mentioning or discussing Gulla, etc, previous art is not required to make the combination of references. Gulla's teaching as to turnovers at column 2 refers to prior art before Gulla's invention. As to the nickel used, from Harbulak, the Examiner notes that Harbulak is not limited to specific examples, and further notes the combination of Harbulak and Gulla indicating indefinite amounts of turnovers can be achieved. As to the compressive stress, this is provided by the teaching of Parker. Gulla is not required to state all possible uses for its invention. As to applicant's arguments that previously people have not made the combination, referring to the references, this does not show that the combination has never been made, merely that these cited references do not explicitly mention it. (3) As to the 35 USC 103 rejection using Harbulak, Gulla, Parker and GB '063, the Examiner has reviewed applicant's arguments, however, the rejection is maintained. '063 is not provided to address defects of Harbulak, Gulla and Parker, since as noted in section (2) above, the rejection using these references is maintained. It is cited as to the use of sodium saccharin in the bath. (4) As to the 35 USC 103 rejection using Harbulak, GB '134 and Parker, the Examiner has reviewed applicant's arguments, however the rejection is maintained. As to the arguments regarding the use of 2-hydroxypropanoic acid and propanedioic acid and the arguments as to the amount of phosphorous in the plated nickel-phosphorous layer, these only apply to the claims as proposed to be amended, and as the proposed amendment has not been entered as discussed in Box 3 above, they have not been considered. As to applicant's arguments that Harbulak is not really teaching 14-22 MTO, the Examiner notes that Harbulak provides no explicit limitation of the number of MTO's, indicating more than 8 turnovers can be used (applicant's reference to Harbulak's statements of 6-10 are specifically stated by Harbulak to apply to the "prior art practice" (see column 9, line 49)). As noted in MPEP 2121, references are assumed to be operable without applicant providing facts showing otherwise. Moreover, the Examiner combined Harbulak with GB '134 as providing a specific suggestion and method for providing 15-20 plating cycles. As noted in the rejection and as discussed at paragraph 11 of the Final Rejection of April 14, 2009, the present claims as worded allow for the presence of glutamic acid, and therefore the teaching of '134 to use glutamic acid is still acceptable. As to the compressive stress, this is provided by the teaching of Parker. (5) As to the 35 USC 103 rejection using Harbulak, GB '134, Parker and GB '063, the Examiner has reviewed applicant's arguments, however, the rejection is maintained. '063 is not provided to address defects of Harbulak, '134 and Parker, since as noted in section (4) above, the rejection using these references is maintained. It is cited as to the use of sodium saccharin in the bath. .